

Remarks

The present application was filed October 15, 2001 with original claims 1-16. Under a prior election with traverse, Applicant has withdrawn claims 2-13 and 15 from consideration, pending allowance of generic claim 1 and linking claim 16. Under the present non-final Office Action mailed November 10, 2003; claims 1, 14, and 16 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by United States Patent No. 2,063,159, issued on February 27, 1932 to Egbert Groove (Groove '159); and claims 1 and 14 stand objected to due to informalities.

With the addition of new claims 17-22, claims 2-13, 15, and 17-22 have been withdrawn from consideration pending allowance of independent generic claim 1, and independent linking claim 16. It is further noted that, with the addition of new independent claim 21, the Applicant believes that new independent claim 21 stands as the broadest claim presented by the application.

These amendments are believed to be proper, do not introduce new matter, do not narrow the subject matter of the amended claims, and serve to place the application in proper condition for reconsideration and allowance. For reference, the status of the claims is now as follows:

<u>Claim</u>	<u>Status</u>
1 (Currently Amended)	Independent.
2 (Currently Amended)	Depends from claim 1.
3 (Currently Amended)	Depends from claim 1.
4 (Currently Amended)	Independent.
5 (Currently Amended)	Depends from claim 4.
6 (Previously Presented)	Depends from claim 4.
7 (Currently Amended)	Depends from claim 1.
8 (Currently Amended)	Independent.
9 (Previously Presented)	Depends from claim 8.
10 (Previously Presented)	Depends from claim 8.
11 (Currently Amended)	Independent.
12 (Currently Amended)	Depends from claim 11.
13 (Currently Amended)	Depends from claim 11.
14 (Currently Amended)	Depends from claim 1.
15 (Currently Amended)	Independent.
16 (Added on 8/1/03)	Independent.
17 (New)	Depends from claim 1.
18 (New)	Depends from claim 1.
19 (New)	Depends from claim 1.

20 (New)	Depends from claim 1.
21 (New)	Independent.
22 (New)	Independent.

Rejection of Claims Under 35 U.S.C. §102(b)

Claims 1, 14, and 16

The Office Action rejected claims 1, 14, and 16 under 35 U.S.C. §102(b) as being clearly anticipated by Groove '159.

Regarding claim 1, the Applicant generally agrees with the Examiner that Groove '159 discloses adjacent panels in overlapping edge relationship, wherein the first panel has a female sidelap portion comprising a female cavity and a downwardly angled leg portion adjacent said cavity, and the second panel has a male sidelap portion with a tang portion and a fifth leg portion lockingly disposed in the female cavity of the first roof panel, in which the downwardly angled leg portion in conjunction with said tang portion provide a standing seam between the first and second panels formed by pressing the downwardly angled leg portion into mating contact with the tang portion and folding said mated downwardly angled leg and tang portions into adjacency with the fifth leg portion of the second panel (see Groove '159 FIG. 2, col. 3 lines 12 and 13). However, Groove '159 is silent and fails to disclose a standing seam assembly with sidelap shear capacity formed by downwardly forming the standing seam to create an acute angle with respect to a first leg portion of the female sidelap portion of the first panel.

Because Groove '159 fails to disclose and is silent with regard to imparting sidelap shear capacity between adjacent panels by downwardly forming the standing seam to create an acute angle with respect to a first leg portion of the female sidelap portion of the first panel, and further fails to disclose means for increasing the sidelap shear capacity of the standing seam assembly, the Examiner fails to make a prima facie showing of anticipation under 35 U.S.C. §102(b). Accordingly, reconsideration and withdrawal of the rejection of claim 1 is respectfully requested, as well as reconsideration and withdrawal of the rejections of the claims depending therefrom, which includes dependent claim 14.

Claim 16 includes the claim element “steps for forming a standing seam assembly with sidelap shear capacity.” This element is written in accordance with 35 U.S.C. §112, sixth paragraph. The corresponding acts disclosed in the specification that carry out the

recited function at least include; jointly forming a fifth leg portion with a tang extending therefrom of a male sidelap portion of a first panel adjacent a second panel, pressing a downwardly angled leg with hook portion of the second panel into mating contact with the tang extending from the fifth leg portion and folding the resulting mated leg and tang into adjacency with said fifth leg portion to form a standing seam, and downwardly forming the standing seam to create an acute angle with respect to a first leg portion of a female sidelap portion of the second panel to form the standing seam assembly with sidelap shear capacity. See the specification as presently amended at page 15, line 7; page 16, line 1 and the specification as previously amended at page 18, line 5.

Accordingly, the Examiner is *obliged as a matter of law* to construe these elements as the corresponding acts, and equivalents thereof. See *In re Donaldson Company, Inc.*, 16 F.3d 1189 (Fed.Cir.1994) (*en banc*), *B. Braun Medical v. Abbott Lab.*, 43 USPQ2d 1896, 1900 (Fed. Cir. 1997), *Supplemental Examination Guidelines for Determining the Applicability of 35 U.S.C. 112, P6*, 65 FR 38510, Federal Register Vol. 65, No. 120, June 21, 2000, see also *Means or Step Plus Function Limitation Under 35 U.S.C. 112, P6*, Notice, 1162 Off. Gaz. Pat. Office 59 (May 17, 1994).

When the claim is properly construed, it is clear that Groove '159 fails to disclose the acts, or equivalents thereof. Indeed Groove '159 is specifically silent on, and fails to disclose the step of downwardly forming the standing seam to create an acute angle with respect to a first leg portion of a female sidelap portion of the second panel to form the standing seam assembly with sidelap shear capacity.

Accordingly, claim 16 defines subject matter that is patentable over the cited references and reconsideration and withdrawal of the rejection of claim 16 is respectfully requested.

Objection to Claims 1 and 14

Claim 1

The Applicant wishes to thank the Examiner for pointing out the discrepancy within claim 1. Appropriate action has been taken by the Applicant and the misspelled term *sidlap* in claim 1 has been amended to read *sidelap*.

Claim 14

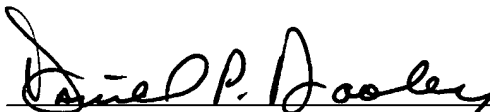
The Applicant wishes to thank the Examiner for pointing out the discrepancies within claim 14. Appropriate action has been taken by the Applicant and the misspelled term *pannel* in claim 14 has been amended to read *panel*. The word *of* in claim 14 has been inserted after *side*.

Conclusion

The Applicant respectfully requests reconsideration and allowance of the claims under examination, and an examination and allowance of the remaining claims, in the application, withdrawn from consideration pending allowance of generic claim 1 and linking claim 16. This Response is intended to be a complete response to the Office Action (Paper No. 10) mailed November 10, 2003.

Should any questions arise concerning this response, the Examiner is invited to contact the below listed Attorneys.

Respectfully submitted,

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